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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,906	04/09/2004	David H. B. Ripin	PC25498A	2445

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PFIZER INC
150 EAST 42ND STREET
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NEW YORK, NY 10017-5612

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,906

Applicant(s)

RIPIN ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL ACTION

Applicant's amendment of 11-14-05 has been fully considered.

- The amended definition of R⁷ and R⁸, or R⁸ and R⁹ forming a ring when attached to the same nitrogen has overcome the previous rejection of 112/2nd paragraph, item (a).
- The deletion of one of the two phrases --“wherein the base is”—has overcome the previous rejection of 112/2nd paragraph, item (b).

Thus, the previous 112/2nd rejection is withdrawn herein.

Applicant argument on the 103 has not been found persuasive, and thus said rejection is maintained herein.

Claims 2 and 30-40 are withdrawn.

Claims 1 and 3-29 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 and 3-23 remain rejected under 35 U.S.C. 103(a) as being obvious over

Sobolov-Jaynes et. al. (US'318) in view of **Berreé et. al.**

Applicants' argument on common ownership has not overcome this rejection. Therefore, the rejection is maintained for the reasons stated in the previous action.

Although the applied reference (US 6,225,318) has the same assignee with the instant application, and might be overcome by showing common ownership, applicants still need to provide evidence of common ownership because the same assignee is **not** by itself sufficient evidence to disqualify the prior art under 35 U.S.C 103(c). Also, a statement concerning common ownership should be **clear and conspicuous**. See attached sheets of MPEP § 706.02(l)(1) and § 706.02(l)(2).

2. Claims 24-29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Berree et. al.** (Syn. Comm., 29(15), 2685-2693 (1999)) in view of **March** (Advanced Organic Chemistry..., 1992). The rejection is maintained for the reasons stated previously and for the following one.

Applicants contended that the rejection recites "bits and pieces from Berree and March using Applicants' disclosure as the blue print to arrive at the claimed invention." Such a statement shows a lack of appreciation for the detailed explanation provided by the previous office action. Said rejection explained why and how **the scientific principle** taught by Berree et. al. and March would render obvious the process recited in claims 24-29. In fact, the previous rejection **matched** the teaching of Berree et. al. to the deprotecting step recited in the instant claims 24, 26 (step a) and 29. Applicant did not refute the fundamental teaching of Berree et. al. Likewise, the teaching of March **matched** step (b) in the instant claim 26, which would supplement the teaching of Berree et. al. to render obvious claim 26 entirely. Claims 24, 26-29

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depend on claim 1 for definitions of variables only. However, the process of converting formula 1 to formula 5 is simply a process of deprotecting the amide alone, or deprotecting the amide to amino followed by acylating the amino. Such a process is **predictable, standard, and well known in the art** as shown by the teachings of Berreé et. al and March. Although claim 25 recites species, it depends on claim 24 for the process, which has been rendered obvious by the above teachings.

Applicants has not refuted the predictability and **reasonable success** shown by the scientific principle in Berreé et. al. and March. Thus, it is maintained that said teachings still render obvious the claimed processes.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account **only knowledge which was within the level of ordinary skill at the time the claimed invention was made**, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

No pending claim is allowed.

Non-elected Subject Matter: This application contains claims 2 and 30-40 drawn to an invention nonelected with traverse in the reply of 7-5-05. A complete reply to the final rejection

must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

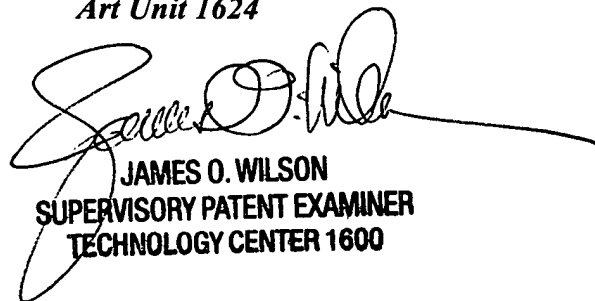
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

01-19-06



Tamthom N. Truong
Examiner
Art Unit 1624



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**>

(c) (1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if —

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

**>I. COMMON OWNERSHIP OR ASSIGNEE PRIOR ART EXCLUSION
UNDER 35 U.S.C. 103(c)<**

*> Enacted on< November 29, 1999, >the American Inventors Protection Act (AIPA) added< subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) **>as< disqualified * prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” *>The 1999< change to 35 U.S.C. 103(c) *>only applied< to all utility, design and plant patent applications filed on or after November 29, 1999**>. The Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), in part, redesignated the former 35 U.S.C. 103(c) to 35 U.S.C. 103(c)(1) and made this provision effective to all applications in which the patent is granted on or after December 10, 2004. Therefore, the provision of 35 U.S.C. 103(c)(1) is effective for all applications pending on or after December 10, 2004, including applications filed prior to November 29, 1999. In addition, this provision applies to all patent applications, including utility, design, plant and reissue applications. The amendment to 35 U.S.C. 103(c)(1) does not affect any application filed before November 29, 1999 and issued as a patent prior to December 10, 2004.

In a reexamination proceeding, however, one must look at whether or not the patent being reexamined was granted on or after December 10, 2004 to determine whether 35 U.S.C. 103(c), as amended by the CREATE Act, applies. For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed on or after November 29, 1999, it is the 1999 changes to 35 U.S.C. 103(c) that are applicable to the disqualifying commonly assigned/owned prior art provisions of 35 U.S.C. 103(c). For a reexamination proceeding of a patent granted prior to December 10, 2004 on an application filed prior to November 29, 1999, neither the 1999 nor the 2004 changes to 35 U.S.C. 103(c) are applicable. Therefore, only prior art under 35 U.S.C. 102(f) or (g) used in a rejection under 35 U.S.C. 103(a) may be disqualified under the commonly assigned/owned prior art provisions of 35 U.S.C. 103(c).<

** For reissue applications, the doctrine of recapture may prevent the presentation of claims in the reissue applications that were amended or cancelled from the application which matured into the patent for which reissue is being sought, if the claims were amended or cancelled to distinguish the claimed invention from 35 U.S.C. 102(e)/103

MPEP

706.02 (1)(1)

+ 706.02 (1)(2)

Attachment

prior art which was **>not able to be excluded under 35 U.S.C. 103(c) in the application that issued as a patent.< If an examiner determines that this situation applies in the reissue application under examination, a consultation with the Office of Patent Legal Administration should be initiated via the Technology Center Special Program Examiner. 35 U.S.C. 103(c) applies only to prior art usable in an obviousness rejection under 35 U.S.C. 103. Subject matter that qualifies as anticipatory prior art under 35 U.S.C. 102 ** is not affected, and may still be used to reject claims as being anticipated. >In addition, double patenting rejections, based on subject matter now disqualified as prior art in amended 35 U.S.C. 103(c), should still be made as appropriate. See 37 CFR 1.78(c) and MPEP § 804.<

The burden of establishing that subject matter is disqualified as prior art is placed on applicant once the examiner has established a *prima facie* case of obviousness based on the subject matter. *>For example, the< fact that the reference and the application have the same assignee is not, by itself, sufficient evidence to disqualify the prior art under 35 U.S.C. 103(c). There must be a statement that the common ownership was “at the time the invention was made.”

See MPEP § 706.02(I)(2) for information regarding establishing common ownership. See MPEP § 706.02(I)(3) for examination procedure with respect to 35 U.S.C. 103(c).**

>II. JOINT RESEARCH AGREEMENT DISQUALIFICATION UNDER 35 U.S.C. 103(c) BY THE CREATE ACT

The CREATE Act (Pub. L. 108-453, 118 Stat. 3596 (2004)) was enacted on December 10, 2004 and is effective for applications for which the patent is granted on or after December 10, 2004. Specifically, the CREATE Act amended 35 U.S.C. 103(c) to provide that:

- subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. 102 shall not preclude patentability under 35 U.S.C. 103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person;
- for purposes of 35 U.S.C. 103, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if
 - the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made,
 - the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement, and
 - the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement;
- for purposes of 35 U.S.C. 103(c), the term “joint research agreement” means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, development, or research work in the field of the claimed invention.

The effective date provision of the CREATE Act provided that its amendments shall apply to any patent (including any reissue patent) granted on or after December 10, 2004. The CREATE Act also provided that its amendment shall not affect any final decision of a court or the Office rendered before December 10, 2004, and shall not affect the right of any party in any action pending before the Office or a court on December 10, 2004, to have that party’s rights determined on the basis of the provisions of title 35, United States Code, in effect on December 9, 2004. Since the CREATE Act also includes the amendment to 35 U.S.C. 103(c) made by section 4807 of the AIPA

(see Pub. L. 106-113, 113 Stat. 1501, 1501A-591 (1999)), the change of “subsection (f) or (g)” to “one or more of subsections (e), (f), or (g)” in 35 U.S.C. 103(c) is now also applicable to applications filed prior to November 29, 1999, that were pending on December 10, 2004.

35 U.S.C. 103(c), as amended by the CREATE Act, continues to apply only to subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g), and which is being relied upon in a rejection under 35 U.S.C. 103. If the rejection is anticipation under 35 U.S.C. 102(e), (f), or (g), 35 U.S.C. 103(c) cannot be relied upon to disqualify the subject matter in order to overcome or prevent the anticipation rejection. Likewise, 35 U.S.C. 103(c) cannot be relied upon to overcome or prevent a double patenting rejection. See 37 CFR 1.78(c) and MPEP § 804.

Because the CREATE Act applies only to patents granted on or after December 10, 2004, the recapture doctrine may prevent the presentation of claims in the reissue applications that had been amended or cancelled (e.g., to avoid a rejection under 35 U.S.C. 103(a) based on subject matter that may now be disqualified under the CREATE Act) during the prosecution of the application which resulted in the patent being reissued.<

706.02(l)(2) [R-3] Establishing Common Ownership > or Joint Research Agreement<

In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned >, or subject to an obligation of assignment to a same person,< at the time the claimed invention was made or **>be subject to a joint research agreement at the time the invention was made<. See MPEP § 706.02(l) for 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103 prior art disqualified under 35 U.S.C. 103(c)>in applications granted as patents prior to December 10, 2004<. See MPEP § 706.02(l)(1) for 35 U.S.C. 102(e)>, (f), or (g)</103 prior art disqualified under 35 U.S.C. 103(c).

I. DEFINITION OF COMMON OWNERSHIP

The term “commonly owned” is intended to mean that the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are entirely or wholly owned by the same person(s) or organization(s)/business entity(ies) at the time the claimed invention was made. If the person(s) or organization(s) owned less than 100 percent of the subject matter which would otherwise be prior art to the claimed invention, or less than 100 percent of the claimed invention, then common ownership would not exist. Common ownership requires that the person(s) or organization(s)/business entity(ies) own 100 percent of the subject matter and 100 percent of the claimed invention.

Specifically, if an invention claimed in an application is owned by more than one entity and those entities seek to exclude the use of a reference under 35 U.S.C. 103, then the reference must be owned by, or subject to an obligation of assignment to, the same entities that owned the application, at the time the later invention was made. For example, assume Company A owns twenty percent of patent Application X and Company B owns eighty percent of patent Application X at the time the invention of Application X was made. In addition, assume that Companies A and B seek to exclude the use of Reference Z under 35 U.S.C. 103. Reference Z must have been co-owned, or have been under an obligation of assignment to both companies, on the date the invention was made in order for the exclusion to be properly requested. A statement such as “Application X and Patent Z were, at the time the invention of Application X was made, jointly owned by Companies A and B” would be sufficient evidence of common ownership.

For applications owned by a joint venture of two or more entities, both the application and the reference must have been owned by, or subject to an obligation of assignment to, the joint venture at the time the invention was made. For example, if Company A and Company B formed a joint venture, Company C, both Application X and Reference Z must have been owned by, or subject to an obligation of assignment to, Company C at

the time the invention was made in order for Reference Z to be properly excluded as prior art under 35 U.S.C. 103(c). If Company A by itself owned Reference Z at the time the invention of Application X was made and Application X was owned by Company C on the date the invention was made, then a request for the exclusion of Reference Z as prior art under 35 U.S.C. 103(c) would not be proper.

As long as principal ownership rights to either the subject matter or the claimed invention reside in different persons or organizations common ownership does not exist. A license of the claimed invention to another by the owner where basic ownership rights are retained would not defeat ownership.

The requirement for common ownership at the time the claimed invention was made is intended to preclude obtaining ownership of subject matter after the claimed invention was made in order to disqualify that subject matter as prior art against the claimed invention.

The question of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual(s) or organization(s) or a legal obligation to assign both the subject matter and the claimed invention to the same individual(s) or organization(s)/business entity(ies) must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art. A moral or unenforceable obligation would not evidence common ownership.

Under 35 U.S.C. 103(c), an applicant's admission that subject matter was developed prior to applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art only under sections 35 U.S.C. 102(e), (f), or (g), and if the subject matter and the claimed invention were commonly owned at the time the invention was made. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982), for a decision involving an applicant's admission which was used as prior art against their application. If the subject matter and invention were not commonly owned, an admission that the subject matter is prior art would be usable under 35 U.S.C. 103. The burden of establishing that subject matter is disqualified as prior art under 35 U.S.C. 103(c) is intended to be placed and reside upon the person or persons urging that the subject matter is disqualified. For example, a patent applicant urging that subject matter is disqualified as prior art under 35 U.S.C. 103(c), would have the burden of establishing that it was commonly owned at the time the claimed invention was made. The patentee in litigation would likewise properly bear the same burden placed upon the applicant before the U.S. Patent and Trademark Office. To place the burden upon the patent examiner or the defendant in litigation would not be appropriate since evidence as to common ownership at the time the claimed invention was made might not be available to the patent examiner or the defendant in litigation, but such evidence, if it exists, should be readily available to the patent applicant or the patentee.

In view of 35 U.S.C. 103(c), the Director has reinstituted in appropriate circumstances the practice of rejecting claims in commonly owned applications of different inventive entities on the grounds of double patenting. Such rejections can be overcome in appropriate circumstances by the filing of terminal disclaimers. This practice has been judicially authorized. See *In re Bowers*, 359 F.2d 886, 149 USPQ 57 (CCPA 1966). The use of double patenting rejections which then could be overcome by terminal disclaimers preclude patent protection from being improperly extended while still permitting inventors and their assignees to obtain the legitimate benefits from their contributions. See also MPEP § 804.

The following examples are provided for illustration only:

Example 1

Parent Company owns 100% of Subsidiaries A and B

employee of Subsidiary B with an obligation to assign to Subsidiary B), which is directed to a possibly unobvious improvement to technology T.

- the inventions of applications #1 and #2 are commonly owned since Subsidiary B is a wholly owned subsidiary of Company A.

The examiner must examine the application as to all grounds except 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103 only if the application file(s) establishes common ownership at the time the later invention was made. Thus, it is necessary to look to the time at which common ownership exists. If common ownership does not exist at the time the later invention was made, the earlier invention is not disqualified as potential prior art under 35 U.S.C. 102(e), (f) and (g) as they apply through 35 U.S.C. 103. An invention is "made" when conception is complete as defined in *Mergenthaler v. Scudder*, 11 App. D.C. 264, 81 O.G. 1417, 1897 C.D. 724 (D.C. Cir. 1897); *In re Tansel*, 253 F.2d 241, 117 USPQ 188 (CCPA 1958). See *Pfaff v. Wells Elecs.*, 525 U.S. 55, 119 S. Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) ("the invention must be ready for patenting . . . by proof that prior to the critical date the inventor had prepared drawing or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention.") Common ownership at the time the invention was made for purposes of obviating a 35 U.S.C. 102(e) / 35 U.S.C. 103, 35 U.S.C. 102(f) / 35 U.S.C. 103 or 35 U.S.C. 102(g) / 35 U.S.C. 103 rejection may be established irrespective of whether the invention was made in the United States or abroad. The provisions of 35 U.S.C. 104, however, will continue to apply to other proceedings in the U.S. Patent and Trademark Office, e.g. in an interference proceeding, with regard to establishing a date of invention by knowledge or use thereof, or other activity with respect thereto, in a foreign country. The foreign filing date will continue to be used for interference purposes under 35 U.S.C. 119(a)-(d) and 35 U.S.C. 365.

II. EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP

It is important to recognize just what constitutes sufficient evidence to establish common ownership at the time the invention was made. The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. *In re Onda*, 229 USPQ 235 (Comm'r Pat. 1985).

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. See "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (December 26, 2000). The applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO.

The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f),

and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

“Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z.” This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

In rare instances, the examiner may have independent evidence that raises a material doubt as to the accuracy of applicant’s representation of either (1) the common ownership of, or (2) the existence of an obligation to commonly assign, the application being examined and the applied U.S. patent or U.S. patent application publication reference. In such cases, the examiner may explain why the accuracy of the representation is doubted, and require objective evidence of common ownership of, or the existence of an obligation to assign, the application being examined and the applied reference as of the date of invention of the application being examined. As mentioned above, applicant(s) may submit, *in addition to* the above-mentioned statement regarding common ownership, the following objective evidence:

- (A) Reference to assignments recorded in the U.S. Patent and Trademark Office in accordance with 37 CFR Part 3 which convey the entire rights in the applications to the same person(s) or organization(s);
- (B) Copies of unrecorded assignments which convey the entire rights in the applications to the same person(s) or organization(s) are filed in each of the applications;
- (C) An affidavit or declaration by the common owner is filed which states that there is common ownership and states facts which explain why the affiant or declarant believes there is common ownership, which affidavit or declaration may be signed by an official of the corporation or organization empowered to act on behalf of the corporation or organization when the common owner is a corporation or other organization; and
- (D) Other evidence is submitted which establishes common ownership of the applications.

>III. EVIDENCE REQUIRED TO ESTABLISH A JOINT RESEARCH AGREEMENT

Once an examiner has established a *prima facie* case of obviousness under 35 U.S.C. 103(a), the burden of overcoming the rejection by invoking the joint research agreement provisions of 35 U.S.C. 103(c) as amended by the CREATE Act is on the applicant or the patentee. 35 U.S.C. 103(c)(3) defines a “joint research agreement” as a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention, that was in effect on or before the date the claimed invention (under examination or reexamination) was made.

Like the common ownership or assignment provision, the joint research agreement must be shown to be in effect on or before the time the later invention was made. The joint research agreement may be in effect prior to the effective date (December 10, 2004) of the CREATE Act. In addition, the joint research agreement is NOT required to be in effect on or before the prior art date of the reference that is sought to be disqualified.

To overcome a rejection under 35 U.S.C. 103(a) based upon subject matter (whether a patent document, publication, or other evidence) which qualifies as prior art under only one or more of 35 U.S.C. 102(e), (f), or (g) via the CREATE Act, the applicant must comply with the statute and the rules of practice in effect.

If the applicant disqualifies the subject matter relied upon by the examiner in accordance with 35 U.S.C. 103(c) as amended by the CREATE Act and the procedures set forth in